

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 35
U.S.C. 154(b) and 37 C.F.R. §§ 1.702 - 1.705**

This Request for Reconsideration of Patent Term Adjustment is being filed pursuant to 25 U.S.C. § 154(b) and 37 C.F.R. §§ 1.702-1.705 and requests that an additional 490 days of patent term adjustment be granted in addition to the 200 days provided in the Notice of Allowance mailed on September 10, 2007. Applicant submitted an Application for Patent Term Adjustment on March 13, 2009 which is being held in abeyance as premature. The PTO's response to Applicants' prior Application for Patent Term Adjustment is attached herewith—according to that PTO response, no fee is due for reconsideration of issues raised in Applicants' prior Application for Patent Term Adjustment because \$200 was submitted pursuant to 37 CFR 1.18(e) along with the prior Application for Patent Term Adjustment. If any additional fee is due, please deduct such fee from deposit account number 02-1818. Enclosed herewith is a statement of facts supporting this application for Patent Term Adjustment as required by 37 C.F.R. § 1.705(b)(2).

STATEMENT OF FACTS UNDER 37 C.F.R. § 1.705(b)(2)

Pursuant to 37 C.F.R. § 1.705(b)(2) Applicants respectfully submit the following Statement of Facts in support of their Application for Patent Term Adjustment. Applicants hereby request that an additional 490 days of adjustment be granted in addition to the 200 days

of patent term adjustment previously accorded in the Issue Notification mailed on May 20, 2009. The requested 490 additional days are the number of days between January 15, 2005 (the day after three years from the application's filing date) and May 19, 2006 (the filing of the first RCE). Applicants are entitled to this additional patent term adjustment under 35 U.S.C. § 154(b)(1)(B), 37 C.F.R. §§ 1.702(b) and 1.703(b)(1) in view of *Wyeth et al., v. Dudas*, Civ. Action No. 07-1492 (JR) (D.D.C. September 30, 2008).

As currently codified, 35 U.S.C. § 154(b) provides three guarantees of patent term, two of which are relevant here. The first is found in subsection (b)(1)(A), the “[g]uarantee of prompt Patent and Trademark Office response.” It provides a one-day extension of patent term for every day that issuance of a patent is delayed by a failure of the PTO to comply with various enumerated statutory deadlines: 14 months for a first office action; four months to respond to a reply; four months to issue a patent after the issue fee is paid; and the like. See 35 U.S.C. § 154(b)(1)(A)(i)-(iv). Periods of delay that fit under this provision are referred to as “A delays.” The second relevant provision is the “[g]uarantee of no more than 3-year application pendency.” Under this provision, a one-day term extension is granted for every day greater than three years after the filing date that it takes for the patent to issue, regardless of whether the delay is the fault of the PTO. See 35 U.S.C. § 154(b)(1)(B). The period that begins after the three-year window has closed is referred to as the “B delay.” According to *Wyeth*, if an “A delay” occurs on one calendar day and a “B delay occurs on another, they do not overlap and § 154(b)(2)(A) does not limit the extension to one day. *Id.* at 8.

The B delay regulations appear at 37 C.F.R. § 1.702(b) and state that the term of a patent shall be adjusted if its issuance was delayed due to the failure of the USPTO to issue the patent within three years after filing of the application. Under § 1.703(b)(1), the amount of patent term adjustment based upon the USPTO's failure to issue a patent within three years excludes the amount of time between filing of an RCE and the issue date of the patent. Since the period between the filing of an RCE and the issue date is excluded under § 1.703(b)(1), the amount of adjustment pursuant to § 1.702(b) can be determined independent of the issue date for the present application as an RCE was filed on May 19, 2006. Thus, Applicants are entitled to an additional patent term adjustment under §§ 1.702(b) and 1.703(b)(1) equal to the number of days between (i) the day after three years from the filing of the application; and (ii) the filing of an RCE. These B delay days do not fall on the same calendar day as any A delay days. The present

application was filed on January 14, 2002; the day after three years from the filing date is therefore January 15, 2005. Additionally, an RCE was filed in the present application on May 19, 2006. Thus, pursuant to § 1.703(b)(1), Applicants are entitled to a patent term adjustment of a period of equal to the number of days between January 15, 2005 and May 19, 2006. This period of time is equal to 490 days and was not included in the 200 days of patent term adjustment stated in the Notice of Allowance. Applicants respectfully request that the patent granted on the present application be granted an additional 490 days of patent term adjustment pursuant to §§ 1.702(b) and 1.703(b)(1) in addition to the 200 days of patent term adjustment indicated in the Notice of Allowance. Thus, pursuant to § 1.703(f), the present application is entitled to a total of 690 days of patent term adjustment.

A summary of the relevant dates is as follows:

Application filing Date:	January 14, 2002
Application filing Date + 14 months:	March 14, 2005
Date of first Office Action:	October 6, 2004
Filing Date + 3 years:	January 14, 2005
RCE filing Date:	May 19, 2006
Patent Issue Date:	June 9, 2009

Adjustment Period	Number of Days	37 C.F.R.
March 15, 2003 – October 6, 2004	572	§§ 107.02(a)(1) and 1.703(a)(1)
April 28, 2005	-1	§ 1.704(b)
April 28, 2005 – October 20, 2005	-176	§ 1.704(b)
April 10, 2006 – May 19, 2006	- 39	§ 1.704(b)
October 18, 2006 – January 17, 2007	-92	§ 1.704(b)
January 18, 2007	-1	§ 1.704(b)
July 20, 2007 – August 21, 2007	-30	§ 1.704(b)
December 14, 2007 – October 14, 2008	- 215	§ 1.704(b)
January 15, 2005 – May 19, 2006	489	§ 1.702(b) and 1.703(b)
Total	689	

Pursuant to § 1.705(b)(2)(iii), Applicants submit that the present application is not subject to a terminal disclaimer.

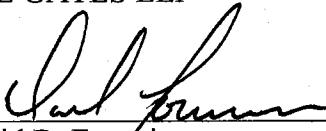
Pursuant to § 1.705(b)(2)(iv)(B), Applicants submit that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the present application as set forth in § 1.704.

Conclusion

Applicants submit that in view of the foregoing, the present application is entitled to an additional 490 days of patent term adjustment beyond the 200 days to which the Office has already determined the present application is entitled. Applicants therefore request the USPTO to reinstate the period of term adjustment accordingly. If, for any reason, direct communication would help facilitate this request for reconsideration, please feel free to contact the undersigned.

Respectfully submitted,

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Reg. No. 51,696

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Enclosure

PTO's response to Applicants' prior Application for Patent Term Adjustment



UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

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OFFICE OF PETITIONS

In re Application of :
Yang et al. :
Application No. 10/047,352 : ON APPLICATION FOR
Filed: January 14, 2002 : PATENT TERM ADJUSTMENT
Atty Docket No. 0109015/024 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 35 U.S.C. 154(b) and 37 C.F.R. §§1.702 - 1.705 filed March 16, 2009. Applicants submit that the application is entitled to an additional 490 days of patent term adjustment, which would increase the patent term adjustment from 200 days at the time of the mailing of the notice of allowance to 690 days. Citing Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), applicants request this correction on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will be entered pursuant to § 1.703(b)).

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K&L GATES LLP
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INTELLECTUAL PROPERTY DOCKET

MAY 13 2009

ATTY: _____

DOCKET #: _____

100-109015-24

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

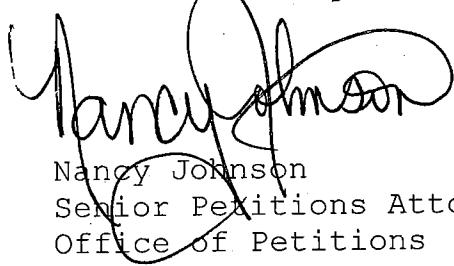
It is noted that a Request for Continued Examination (RCE) was first filed in this application on May 19, 2006.

The determination of the patent term adjustment at the time of the mailing of the notice of allowance remains two hundred (200) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded and is not consumed by the filing of a request for continued examination).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

PALM INTRANET

Day : Tuesday
 Date: 5/5/2009
 Time: 19:56:04

PTA Calculations for Application: 10/047352

Application Filing Date:	01/14/2002	PTO Delay (PTO):	756
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	556
Post-Issue Petitions:	0	Total PTA (days):	200
PTO Delay Adjustment:	0		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
85	01/13/2009	MAIL NOTICE OF ALLOWANCE	184		59
84	01/09/2009	ISSUE REVISION COMPLETED			
83	01/09/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
82	01/09/2009	CASE DOCKETED TO EXAMINER IN GAU			
81	12/16/2008	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
80	12/16/2008	DOCUMENT VERIFICATION			
79	12/08/2008	NOTICE OF ALLOWABILITY			
73	10/14/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
72	10/14/2008	REFERENCE CAPTURE ON IDS			
71	10/14/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		215	59
70	10/14/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
69	10/16/2008	DATE FORWARDED TO EXAMINER			
68	09/29/2008	SUPPLEMENTAL RESPONSE			
67	08/22/2008	DATE FORWARDED TO EXAMINER			
66	07/28/2008	SUPPLEMENTAL RESPONSE			
65	08/06/2008	DATE FORWARDED TO EXAMINER			
64	07/28/2008	SUPPLEMENTAL RESPONSE			
63	02/01/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
62	06/09/2008	DATE FORWARDED TO EXAMINER			
61	06/06/2008	SUPPLEMENTAL RESPONSE			
60	04/07/2008	DATE FORWARDED TO EXAMINER			
59	03/13/2008	RESPONSE AFTER NON-FINAL ACTION			

58	02/01/2008	ELECTRONIC INFORMATION DISCLOSURE STATEMENT		
57	08/26/2003	CLAIMS PTO		
56	02/01/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
55	12/13/2007	MAIL NON-FINAL REJECTION		
54	12/10/2007	NON-FINAL REJECTION		
53	08/24/2007	DATE FORWARDED TO EXAMINER		
52	08/21/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE		
51	08/24/2007	DATE FORWARDED TO EXAMINER		
50	08/21/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)	32	42
49	08/24/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)		
48	08/21/2007	REQUEST FOR EXTENSION OF TIME - GRANTED		
47	08/21/2007	WORKFLOW - REQUEST FOR RCE - BEGIN		
46	07/23/2007	MAIL ADVISORY ACTION (PTOL - 303)		
45	07/20/2007	ADVISORY ACTION (PTOL-303)		
44	06/28/2007	DATE FORWARDED TO EXAMINER		
43	06/20/2007	AMENDMENT AFTER FINAL REJECTION		
42	04/20/2007	MAIL FINAL REJECTION (PTOL - 326)		
41	04/16/2007	FINAL REJECTION		
40	01/26/2007	DATE FORWARDED TO EXAMINER		
39	01/18/2007	SUPPLEMENTAL RESPONSE	1	37
38	01/24/2007	DATE FORWARDED TO EXAMINER		
37	01/17/2007	RESPONSE AFTER NON-FINAL ACTION	92	35
36	01/17/2007	REQUEST FOR EXTENSION OF TIME - GRANTED		
35	07/17/2006	MAIL NON-FINAL REJECTION		
34	07/13/2006	NON-FINAL REJECTION		
33	05/20/2006	DATE FORWARDED TO EXAMINER		
32	05/19/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE		
31	05/20/2006	DATE FORWARDED TO EXAMINER		
30	05/19/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)	39	27
29	05/20/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)		

28	05/19/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
27	01/10/2006	MAIL FINAL REJECTION (PTOL - 326)			
26	01/09/2006	FINAL REJECTION			
25	10/29/2005	DATE FORWARDED TO EXAMINER			
24	10/21/2005	RESPONSE AFTER NON-FINAL ACTION	176	19	
23	10/21/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
22	07/19/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
21	06/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
20	05/11/2005	DATE FORWARDED TO EXAMINER			
19.1	04/28/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
19	04/28/2005	RESPONSE AFTER NON-FINAL ACTION	1	18	
18	01/27/2005	MAIL NON-FINAL REJECTION			
17	01/24/2005	NON-FINAL REJECTION			
16	01/18/2005	WORKFLOW INCOMING AMENDMENT IFW			
15	11/16/2004	DATE FORWARDED TO EXAMINER			
14	11/01/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
13	11/01/2004	WORKFLOW INCOMING AMENDMENT IFW			
12	10/06/2004	MAIL RESTRICTION REQUIREMENT	572		-1
11	10/01/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
10	08/26/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
9	03/07/2002	CASE DOCKETED TO EXAMINER IN GAU			
8.7	01/14/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	01/14/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7	01/14/2002	PRELIMINARY AMENDMENT			
6	02/19/2002	APPLICATION DISPATCHED FROM OIPE			
5	02/19/2002	APPLICATION IS NOW COMPLETE			
3	02/08/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	01/29/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/14/2002	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION